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RCE for 09/627,401

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"VIRTUAL PRINT MARKETPLACE"

Pending claims are still obvious with 35 USC 103(a) rejection because a primary reference (Huberman - US Patent 5,826,244) are implemented by Shiota - US Pat. 6324521, Tannenbaum(DERWENT-ACC-NO: 2000-072115), Murata(DERWENT-ACC-NO: 1999-086425), McGovern - US Pat.5,918,207, Enomoto - US Pat. 5,974,401.

1. (Currently Amended) A method of creating, via a network, a virtual print market places in which a market portal gathers information from a service provider and an interactive shop to create a relationship between the service provider and the interactive shop, and the interactive shop offers products and/or services based on the information gathered by the market portal, the method comprising:

- collecting, using the market portal, market information, comprising an identify of service providers and the print services and pricing provided by each of the service providers; comprising an identity of service providers and the print services and pricing provided by each of the service providers;
- obtaining, using the market portal, criteria established by an interactive shop for selecting service providers to provide the print services; and
- selecting, using the market portal, one or more service providers identified using in the market information to provide the set of print services based on the criteria and the market information,

wherein the interactive shop provides a graphical user interface for access by its patrons to order products and services of the virtual print market place offered by the interactive shop, to submit payment information, to transfer digital images, and/or to submit feedback.

2. (Original) A method, according to Claim 1, wherein the method further comprising:

- forwarding an order for services placed in the interactive shop to at least one of the selected service providers via a market portal.

3. (Original) A method according to Claim 2, further comprising: transmitting digital data from the interactive shop to the at least one of the selected service providers via another communication channel that excludes the market

4. (Original) A method according to Claim 1, further comprising: updating the market information to reflect amount, type and price of print services ordered in an interactive shop from a service provider.

5. (Original) A method according to Claim 1, further comprising: updating the market information to reflect level of satisfaction associated with a service provider,

6. (Original) A method according to Claim 1 further comprising: forwarding an order from the interactive shop to at least one of the selected service providers via a market portal; transmitting a status of the order to the market portal, and rendering payment when the market portal determines that the ordered print services have been provided.

7. (Original) A method according to Claim 6, the step of rendering payment further comprising:  
- collecting fees from a patron of the interactive shop that placed the order; and  
- rendering payment to the one of the selected service providers from the collected fees.

8. (Original) A method according to Claim 6 further comprising: rendering a percentage of the fees collected from the patron as payment to the interactive shop.

9. (Original) A method according to Claim 6 further comprising: rendering a percentage of the fees collected from the patron as payment to the provider providing the market portal.

10. (Original) A method according to Claim 1, wherein the step of selecting service providers is performed in anticipation of the ~~placement~~ of an order for print services

11. (Original) A method according to Claim 1, wherein the step of selecting service providers is performed in response to the placement of an order for print services.

12. (Original) A method according to Claim 1, further comprising: establishing a relationship between the interactive shop and a selected service provider guaranteeing the purchase and supply respectively of a certain quantity of a given service; and updating the market information to specify the quantity of the given service guaranteed.

13. (Original) A method according to Claim 12 further comprising: updating the quantity to reflect filled orders of the print services.

14. (Original) A method according to Claim 1 wherein the market information includes an identity of interactive shops,

15. (Currently Amended) A method of creating, via a network, a virtual print market place, in which a market portal gathers information from a service provider and an interactive shop to create a relationship between the service provider and the interactive shop, and the interactive shop offers products and/or services based on the information gathered by the market portal, the method comprising:

- collecting, using the market portal, market information comprising an identity of service providers, interactive shops, a standardized set of print services and pricing provided by each of the service providers;
- obtaining, using the market portal, a bid from a service provider identifying a print service and terms for providing the print service;
- obtaining a bid from an interactive shop identifying the print service and terms for purchasing the print service;
- determining compatibility between the service provider and the interactive shop; and
- establishing an agreement between the service provides and the interactive shop when the terms of the print service and the interactive shop are compatible, wherein the service provider agrees to provide and the interactive shop agrees to purchase the service according to the terms, and  
wherein the interactive shop provides a graphical user interface for access by its patrons to order products and services of the virtual print market place offered by the

interactive shop, to submit payment information, to transfer digital images, and/or to submit feedback.

16. (Original) A method according to Claim 15 wherein the terms include a price and quantity of the print service.

17. (Original) A method according to Claim 15 wherein the terms include a duration.

18. (Original) A method according to Claim 15 further comprising: an obtaining step to obtain a bid from at least one other service provider to assume a portion of the service provider's agreement with the interactive shop; and an establishing step to establish a new agreement between the at least one other service provider and the interactive shop.

19. (Original) A method according to Claim 18 wherein the portion of the agreement represents any remaining quantity of print services not already provided by the service provider.

20. (Original) A method according to Claim 18 wherein the portion of the agreement represents less than all of the remaining quantity of print services not already provided by the service provider.

21. (Original) A, method according to Claim 15 further comprising: an obtaining step to obtain a bid from at least one other interactive shop to assume a portion of the interactive shop's agreement with the service provider, and an establishing step to establish a new agreement between the at least one other interactive shop and the service provider.

22. (Original) A method according to Claim 21 wherein the portion of the agreement represents any remaining quantity of print services not already purchased by the interactive shop.

23. (Original) A method according to Claim 21 wherein the portion of the agreement represents less than all of the remaining quantity of print services not already purchased by the interactive shop.

24. (Currently Amended) A computer-readable memory medium storing computer-executable process steps to create, via a network, a virtual print market place, in which a market portal gathers information from a service provider and an interactive shop to create a relationship shop, and the interactive shop

offers products and/or services based on information gathered between the service provider and the interactive gathered by the market portal, the steps comprising:

- a collecting step to collect, using the market portal, market information-äc comprising an identity of service providers and the print services and pricing provided by each of the service providers;

- an obtaining step to obtain, using the market portal, criteria established by an interactive shop for selecting service providers to provide print services; and

- a selecting step to select, using the market portal, one or more service providers identified using is the market information to provide the set of print services based on the criteria and the market information,

wherein the interactive shop provides a graphical user interface for access by its patrons to order products and services of the virtual print market place offered by the interactive shop, to submit payment information to transfer digital images, and/or to submit feedback.

25. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 24, wherein an order is placed in the interactive shop, further comprising: a forwarding step to forward an order placed in the interactive shop to at least one of the selected service providers via a market portal.

26. (Original) A, computer-readable memory medium storing computer-executable process steps according to Claim 25, further comprising:

a transmitting step to transmit digital data from the interactive shop to the at least one of the selected service providers via another communication channel that excludes the market portal.

27. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 24, further comprising:

an updating step to update the market information to reflect amount, type and price of print services ordered in an interactive shop from a service provider.

28. (Original) A computer-readable memory medium storing computer-executable process steps according Claim 24, feather comprising:

an updating step to update the market information to reflect level of satisfaction associated with a service provider.

29. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 24 further comprising:

a forwarding step to forward an order from the interactive shop to at least one of the selected service providers via a market portal;

a transmitting step to transmit a status of the order to the market portal; and a rendering step to render payment when the market portal determines that the ordered print services have been provided.

30. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 29, further comprising:

a collecting step to collect fees from a patron of the interactive. shop that placed the order; and

a rendering step to render payment to the one of the selected service providers from the collected fees.

31. (Original) A computer readable memory medium storing computerexecutable process steps according Claim 29 futher comprising:

rendering step to render a percentage of the fees collected from the patron as payment to the interactive shop.

32. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 29 further comprising:

a rendering step to render a percentage of the fees collected from the patron as payment to the provider providing the market portal.

33. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 24 wherein the step of selecting service providers is performed in anticipation of the placement of an order for print services.

34. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 24 wherein the step of selecting service providers is performed in response to the placement of an order for print services.

35. (Original) A computer-readable memory medium storing computerexecutable process steps according to Claim 24, further comprising:

an establishing step to establish a relationship between the interactive shop and a selected service provider guaranteeing the purchase and supply respectively of a certain quantity of a given print service; and  
an updating step to update the market information to specify the quantity of the given print service guaranteed.

36. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 35 further comprising:  
an updating step to update the quantity to reflect filled orders of the print services,

37. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 24 wherein the market information includes identity of interactive shops.

38. (Currently Amended) A computer-readable memory medium storing computer-executable process steps to create, via a network, a virtual print market place, in which a market portal gathers information from a service provider and an interactive shop to create a relationship between the service provider and the interactive shop, and the interactive shop offers products and/or services based on the information gathered by the market portal, the steps comprise:

- a collecting step to collect, using the market portal, market information, comprising an identity of service providers, interactive shops, a standardized set of print services and pricing provided by each of the service providers;
- an obtaining step to obtain using the market portal a supply bid from a service provider identifying a print service and terms for providing the print service;
- an obtaining step to obtain, using the market portal, a purchase bid from an interactive shop identifying the print service and terms for purchasing the print service;
- a determining step to determine, using the market portal, compatibility between the service provider and the interactive shop; and
- an establishing step to establish, using the market portal, an agreement between the service provider and the interactive shop when the terms of the print service and the interactive shop are compatible, wherein the service provider agrees to provide and the interactive shop agrees to purchase the print service according to the terms, and wherein the print service is offered by the interactive shop in a graphical user interface

which is provided by the interactive shop and offers products and/or services of the virtual print market place. the interface is for access by patrons to order the print service, submit payment information, transfer digital images, and/or submit feedback.

39. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 38 wherein the term include a price and quantity of the print service.

40. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 38 wherein the terms include a duration.

41. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 38 further comprising:  
an obtaining step to obtain a bid from at least one other service provider to assume a portion of the service provider's agreement with the interactive shop; and  
an establishing step to establish a new agreement between the at least one other service provider and the interactive shop.

42. (Original) ,A computer-readable memory medium storing computer-executable process steps according to Claim 41 wherein the portion of the agreement represents any remaining quantity of print service not already provided by the service provider.

43. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 41 wherein the portion of the agreement represents less than all of the remaining quantity of print service not already provided by the service provider.

44. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 38 further comprising:  
an obtaining step to obtain a bid from at least one other interactive shop to assume a portion of the interactive shop's agreement with the service provider; and  
an establishing step to establish a new agreement between the at least one other interactive shop and the service provider.

45. (Original) A computer-readable memory medium storing computer-executable process steps according to Claim 44 wherein

the portion of the agreement represents any remaining quantity of print service not already purchased by the interactive shop.

46. (Original) A computer-readable memory medium storing computer-executable process steps according to claim 44 wherein the portion of the agreement represents less than all of the remaining quantity of print service not already purchased by the interactive shop.

① 47. (Previously Presented) A method of providing services from a service provider to a client device via a network, a server connected to the service provider and the client device executes the steps of:  
collecting market information, wherein the market information includes an identity of a plurality of service providers and services provided by each of the service providers;  
selecting one or more service providers and/or services identified in the market information based on a request from the client device; and  
offering the selected service providers and/or services to the client device.

48. (Previously Presented) A method according to Claim 47 further comprising:  
① obtaining criteria established by an interactive shop device; wherein the selecting step selects on the basis of the criteria and the interactive shop indicates the service providers and of the services to the client device.

① 49. (Previously Presented) A method according to Claim 1, wherein an intermediary of the service provider and the interactive shop performs the collecting, obtaining and selecting steps.

50. (Previously Presented) A method according to Claim 15, wherein an intermediary of the service provider and the interactive shop performs the collecting, determining and obtaining steps.

① 51. (Previously Presented) A method according to Claim 24, wherein an intermediary of the service provider and the interactive shop performs the collecting, obtaining and selecting steps.

52. (Previously Presented) A method according to Claim 38, wherein an intermediary of the service provider and the

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interactive shop performs the collecting, determining and obtaining steps.

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(see 37 CFR 1.436).

The claims must "define the matter for which protection is sought." Claims must be clear and concise. As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought ("the characterizing portion").

Pending claims contain standardized computer's definitions which are not invented by the applicant. The examiner submits that the above claimed limitations are inherent/obvious in cited references. Cited prior art limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to an analogous application as what the applicants did. The cited references are not limited to described embodiments in these disclosures. It is reasonable that various modifications and variations of described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these disclosures have been described in connection with specific preferred embodiments, it should be understood that their intentions should not be limited to such specific embodiments.

## F. Propriety of combining references

### 1. Bodily incorporation

In re Bozek, 163 USPQ 545 (CCPA 1969)

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Mapelsden, 51 CCPA 1123, 329 F.2d 321, 141 USPQ 30 (1964). In re Henley, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956).

In re Richman, 165 USPQ 509 (CCPA 1970)

The question in a rejection for obviousness on a combination of references is what the secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in the basic reference structure.

In re Van Beckum, 165 USPQ 47 (CCPA 1971)

We would note that it is well settled that the test of obviousness is not whether the features of one reference can be bodily incorporated into the structure of another and proper inquiry should not be limited to the specific structure shown by the references, but should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained those concepts would suggest to one skilled in the art the modifications called for by the claims.

In re Henley, 112 USPQ 56 (CCPA 1956)

The issue lies in what the combination of references makes obvious to the person of ordinary skill and not whether a feature of one reference can be bodily incorporated in the other too produce the subject matter claimed.